

REMARKS/ARGUMENTS

Independent claim 1 has been amended to recite that the first and second rollers are synchronized with one another such that the perforation means always engage the felt material at the same locations thereby forming openings in the felt material in which the perforation means always engage. Support for this amendment can be found at least on paragraph [0020] of the present publication (i.e., U.S. Publication 2006/0128245). As such, no new matter has been entered.

I. Obviousness Rejections

To establish a *prima facie* case of obviousness, according to a test predominately used by the courts, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to the Supreme Court's decision in *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007), it is noted that the Court did not dismiss the usefulness the well-established "teaching, suggestion, or motivation" test set forth above, but merely cautioned against its rigid application. The Supreme Court in *KSR* commented that the Federal Circuit "no doubt has applied the test in accord with these principles [set forth in *KSR*] in many cases." *Id.* at ___, 82 USPQ2d at 1396. However, the Supreme Court also opined that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . ." *Id.* at ___, 82 USPQ2d at 1395-96. Regardless of the precise test used, the Court, quoting *In re Kahn*, cautioned that "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with

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some rational underpinning to support the legal conclusion of obviousness.' " *Id.* at __, 82 USPQ2d at 1396.

Applicants submit that the Office has not proven a *prima facie* case of obviousness because none of the cited references, whether considered alone or in any combination, teach, suggest, or otherwise render predictable a method for the manufacture of a perforated nonwoven by directing the nonwoven between two rollers in which one of the rollers includes heated perforating means provided about the entire outer circumference thereof and the second roller having an outer surface covered by a felt material as recited in independent claim 1. That is, the cited references (considered alone or in any combination) do not teach, suggest, or otherwise render predictable a first roller including heated perforating means provided about the entire outer circumference in combination with a second felt covered second roller in which the first and second rollers are synchronized with one another such that the perforation means always engage the felt material at the same locations thereby forming openings in the felt material in which the perforation means always engage as recited in independent claim 1.

In addition to the cited references (alone or in any combination) failing to teach, suggest or render predictable all aspects of the currently claimed invention, Applicants reiterate from the previous response that the Office has not proven a *prima facie* case of obviousness because the purported combination of references is not predictable in the fashion put forth by the Office and as required by KSR because the primary reference teaches away from the modification proposed by the Office and any such modification would render the invention of the primary reference unsatisfactory for its intended purpose as discussed in detail below.

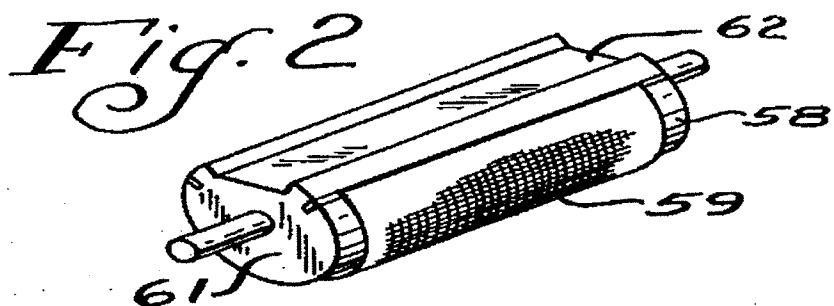
A.

Claims 1, 3, 6-8 and 30-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,965,906 to Karami et al. (hereinafter "Karami") in view of U.S. Patent No. 4,257,842 to Ciaccia et al. (hereinafter "Ciaccia") and EP 0598970 to Giacometti (hereinafter "Giacometti") as evidenced by Mish et al.; Merriam Webster's Collegiate Dictionary, page 840 (hereinafter "Mish"). The Office cites Mish for support that paper-wool encompasses felt. Applicants respectfully traverse this rejection.

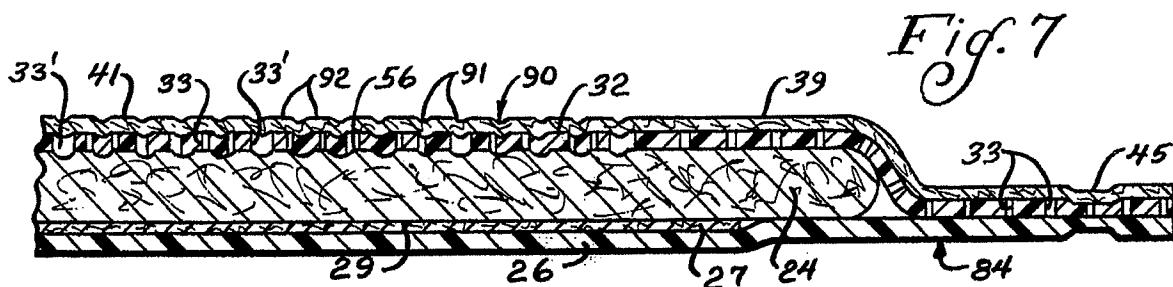
1. Any combination of the cited references does not teach, suggest, or otherwise render predictable all aspects of the currently claimed invention.

Karami is generally directed to an absorbent article having a front and back surface, a fluid impervious backing sheet covering the back surface of the pad, and a perforated thermoplastic film covering the front surface of the pad. A pattern is fused into the film to enlarge a plurality of perforations in the film and fuse the film to the pad in the locality of the pattern. See column 1, lines 55-61. The apparatus taught by Karami for producing such an article includes a perforator (42) having a plurality of needles (46) to impart perforations through webs (32) and (39). The apparatus includes a heating member (58) separate from the perforator (42). The heating of the web sections containing perforations enlarges the diameter of the perforations. See column 6, lines 2-5.

However, Karami expressly teaches that the heating member (58) has a "cutout portion (62) to prevent contact of the heating member (58) against the webs (32) and (39) intermediate the pads (24) as they pass beneath the member (58)." See column 4, lines 22-25. That is, Karami expressly teaches that the sections of the webs that will not be positioned over the pad should not be heated (to avoid enlarging the perforations at these locations). Due to this essential requirement for the methods of Karami, all heating means disclosed by Karami are configured such that these sections of the webs are not heated. For instance, the heating member (58) of Karami is illustrated in Figure 2 (provided below for ease of reference).



As can be seen from Figure 2, the heating member (58) does not have a perforating means provided about the entire outer circumference thereof. Accordingly, the heating member (58) of Karami's apparatus enables the enlargement of perforations located over the pad (24), while intentionally preventing the enlargement of any perforations located in the web sections located between the absorbent pads. For example, Figure 7 of Karami illustrates the comparison of non-heated perforations (33) with the heated (and therefore enlarged) perforations (33'). As can be seen in Figure 7, the perforations (33) located in the web sections not positioned over the pad (24) are not enlarged because they have not been heated. As such, the webs can be more easily and securely sealed around the pad. Figure 7 has been provided below for ease of reference.

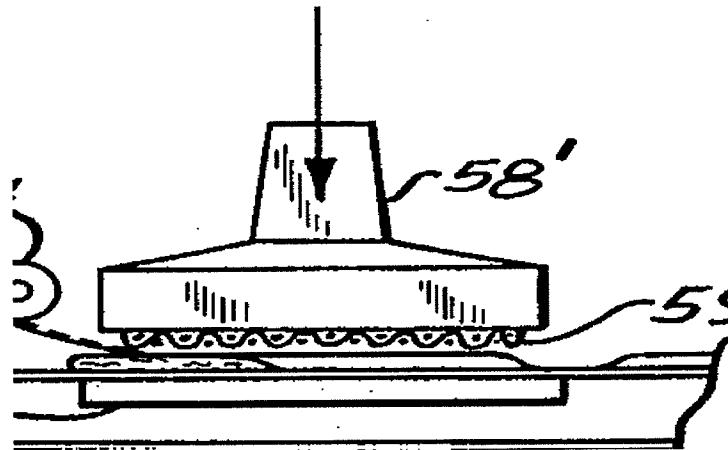


As an alternative, Karami teaches that the apparatus can include a reciprocating heating element (58') for fusing a pattern in the web against the front surface of the pad. This heating element (58') is illustrated in Figures 3-4. As shown in Figure 3, the heating element (58') lowers to heat the web positioned over a pad and rises so that the web sections located between two pads is not heated. Figure 3 is provided below.

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Thus, Karami again expressly teaches that only the web sections positioned over a pad should be heated to enlarge the size of the perforations. As such, Karami clearly teaches that the method/apparatus should only provide sectional heating of the web to ensure that only the web sections located over the pad are heated (and thus selectively enlarging the perforations at these web sections). As such, any proposed modification of heating the perforator in the apparatus of Karami would require blatant disregard for the express teaching of Karami to avoid the heating of all sections of the webs.

Contrary to the teachings of Karami, the currently claimed invention uses a roller having a heated perforation means extending outwardly from the outer surface about the entire outer circumference of the roller. Accordingly, the currently claimed invention does not provide the sectional heating taught as essential to the apparatus/method of Karami.

As such, Karami clearly does not teach, suggest, or otherwise render predictable a method for the manufacture of a perforated nonwoven by directing the nonwoven between two rollers in which one of the rollers includes heated perforating means provided about the entire outer circumference thereof and the second roller having an outer surface covered by a felt material as recited in independent claim 1.

As acknowledged by the Office, Karami does not teach a felt surface on the second roller. The Office, however, argues that Ciaccia cures this deficiency.

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Ciaccia is directed to embossed wallpapers and processes for the production of embossed wallpapers. Ciaccia teaches that the embossing operation can be carried out by passing the sheet between two cylinders (rollers) of which one is an embossing cylinder that in general is made of steel, while the other cylinder is a contrasting one and may be made of hard rubber, for instance of neoprene, or of paper-wool. However, Ciaccia does not cure the noted deficiencies of Karami.

As acknowledged by the Office, Karami does not teach heating the perforator means extending outwardly about the entire outer circumference of a first roller. The Office, however, argues that Giacometti cures this deficiency. In particular, the Office argues that it "would have been obvious... to heat the perforation means as taught by Giacometti in Karami's perforation process in order to facilitate the plastic deformation of the web material". See pages 3 and 4 of the Office Action dated June 23, 2010. Applicants respectfully disagree.

As discussed above, the combination of Karami and Ciaccia does not teach, suggest or otherwise render predictable a method for the manufacture of a perforated nonwoven by directing the nonwoven between two rollers in which one of the rollers includes heated perforating means provided about the entire outer circumference thereof and the second roller having an outer surface covered by a felt material as recited in independent claim 1.

Giacometti is directed to a method for forming a web that is permeable to liquids. The method of Giacometti includes passing a film between two rotating cylinders, in which one of the cylinders includes a studded surface and the other cylinder has a smooth surface. The rotation speed of the smooth surfaced cylinder and the advancing speed of the film is less than that of the studded cylinder so that a slipping action is realized. This slipping action creates holes having strands of partially detached material. Giacometti teaches that one or both of the cylinders can be heated.

However, Giacometti fails to cure the noted deficiencies of the combination of Karami and Ciaccia. That is, any combination of the cited references fails to teach, suggest or otherwise render predictable a method for the manufacture of a perforated nonwoven by directing the nonwoven between two rollers in which one of the rollers includes heated perforating means provided about the entire outer circumference thereof and the second roller having an outer surface

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covered by a felt material as recited in independent claim 1. In other words, Karami does not teach, suggest, or otherwise render predictable a first roller including heated perforating means provided about the entire outer circumference in combination with a second felt covered second roller such that the heated perforating means of the first roller engage into the felt of the second roller as recited in independent claim 1.

2. The proposed modification of Karami with Giacometti is improper because
(i) Karami teaches away from such a modification and (ii) such a combination
would render the invention of Karami unsatisfactory for its intended purpose.

In addition to the cited references (alone or in any combination) failing to teach, suggest or render predictable all aspects of the currently claimed invention, Applicants reiterate that the Office has not proven a *prima facie* case of obviousness because the purported modification of Karami with Giacometti is not predictable in the fashion put forth by the Office and as required by KSR. For instance, Karami teaches away from the modification proposed by the Office and any such modification would render the invention of Karami unsatisfactory for its intended purpose.

As referenced above, the purported combination of references is not predictable in the fashion put forth by the Office and as required by KSR because Karami teaches away from modifying the perforator (42) to be heated because such a modification would result in the enlargement of all perforations. As discussed in detail above, Karami clearly teaches away from enlarging all perforations in the web. For instance, all heating means described by Karami are configured to prevent the heating (and therefore enlargement) of all perforations in the web. That is, Karami teaches that only web sections positioned over the pad should be heated, while perforated web portions located between pads on the driven belt should remain unheated. As such, the perforator of Karami could not be modified to include heated perforating means about the entire surface thereof because all of the perforated sections of the web would be necessarily be heated and enlarged. Such a result is intentionally avoided by the teachings of Karami. Accordingly, such a modification would require the blatant disregard for the express teachings of Karami. Furthermore, any such modification would require a substantial reconstruction of the Karami method/apparatus and render the Karami method/apparatus unsatisfactory for its

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intended purpose. In such scenarios, the combination of references fails to establish a *prima facie* case of obviousness. See MPEP 2143.

In this regard, it would not be predictable to modify the perforator of Karami with the heated cylinder of Giacometti since the apparatus/method of Karami requires sectional heating of the web to ensure that only the web sections located over the pad are heated (and thus selectively enlarging the perforations at these web sections). Any proposed modification of heating the perforator in the apparatus of Karami would be in direct contravention to a primary objective of Karami, namely to avoid the heating of all sections of the web.

Indeed, in KSR in the context of the importance of predictability with respect to propriety of a combination of references, the Supreme Court extensively discusses U.S. v. Adams, 383 U.S. 39 (1966). In U.S. v. Adams, the Supreme Court found the claims not to be obvious even though the claims were drawn to a structure already known in the art that was altered by the substitution of one known element with another with predictable results since the prior art taught away from combining certain ones of the known elements. *Id.* at 50-52. Moreover, as a matter of practice, MPEP § 2143 describes a number of different rationales for obviousness and requires an Examiner to articulate a number of findings to support an obviousness rejection including, in most instances, a finding that the proposed modification or combination would have been predictable to one of ordinary skill in the art. Consistent with the guidance provided by KSR, MPEP § 2143 also repeatedly notes that obviousness cannot be established under a respective rationale in instances in which an Examiner fails to properly establish any one of the requisite findings, such as in the present application in which the combination of Karami and Giacometti does not provide predictable results in light of Karami's express teaching away and the fact that such a modification would render the method/apparatus of Karami unfit for its intended purpose.

For at least these reasons, Applicants submit that the Office has not established a *prima facie* case of obviousness. As such, Applicants request withdrawal of this rejection.

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B.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Karami, Ciaccia, Giacometti, and further in view of U.S. Patent No. 5,521,030 to McGrew (hereinafter “McGrew”). The Office cites McGrew for allegedly teaching a shrinkable hose. Applicants respectfully traverse this rejection.

McGrew is directed to a method for producing durable embossing tools, particularly a embossing roller having a single-piece holographic surface without seams or clamps.

In this regard and as previously discussed, independent claim 1 now pending, from which claim 5 depends, is not obviated by Karami, Ciaccia and Giacometti, either separately or in combination, and McGrew does not remedy any of the noted deficiencies in this regard. Applicant thus submits that this rejection has been overcome and requests withdrawal thereof.

C.

Claims 34 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Karami, Ciaccia, and Giacometti, and further in view of DE 19856223 to Wagner (hereinafter “Wagner”). Applicants note that the Office refers to U.S. Patent No. 6,739,024 as an English translation. Applicants respectfully traverse this rejection.

Wagner is directed to a method for producing a structured, voluminous non-woven web or velourised film from a thermoplastic by producing an unstructured web and subsequently processing this web using a pair of rollers. The pair of rollers consists of a positive roller having numerous positive bodies distributed over the roll sleeve surface and a negative roller having equally as numerous cavities. During the rolling process, the positive bodies engage with the cavities and stretch the unstructured web in the area of the roller engagements in such a way that a deep-drawn web structure with numerous cavities is produced. After the web has passed through a roller gap, the deformed web, still bonded to the positive roller, is brought into contact with a perforating tool and perforated.

In this regard and as previously discussed, independent claim 1 now pending, from which claims 34 and 36 depend, is not obviated by Karami, Ciaccia and Giacometti, either separately or

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in combination, and Wagner does not remedy any of the noted deficiencies in this regard.

Applicant thus submits that this rejection has been overcome and requests withdrawal thereof.

D.

Claim 35 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Karami, Ciaccia, Giacometti, and McGrew, and further in view of the Wagner. Applicants respectfully traverse this rejection.

Each of these references have been discussed above. Independent claim 1 now pending, from which claim 35 depends, is not obviated by Karami, Ciaccia, Giacometti, and McGrew either separately or in combination, and Wagner does not remedy any of the noted deficiencies in this regard. Applicant thus submits that this rejection has been overcome and requests withdrawal thereof.

II. Conclusion

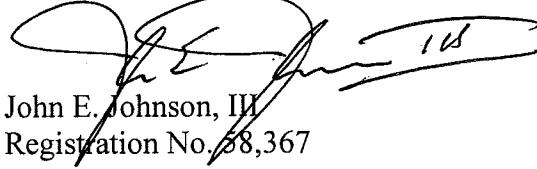
In view of at least the amendments and remarks made above, Applicants submit that the pending claim is in condition for allowance. Applicants respectfully request that the claim be allowed to issue. If the Examiner wishes to discuss the application or the comments herein, the Examiner is urged to contact the undersigned.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

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therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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